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MAILED

SEP 30 2010

OFFICE OF PETITIONS

In re Patent No. 7,379,981

Issue Date: May 27, 2008

Application No. 10/040,150

Filed: January 2, 2002

Attorney Docket No. MESH.0020000

:
: **DECISION ON PETITION**
: **UNDER 37 CFR 1.78(a)(3)**
: **and**
: **UNDER 37 CFR 1.78(a)(6)**

This is a decision on the renewed petition filed August 24, 2010, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed non-provisional applications, and under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional applications, filed by way of a certificate of correction filed concurrently herewith.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Application no. 10/040,150 which was filed after November 29, 2000, matured into Patent No. 7,379,981 on May 27, 2008. The claim for the benefit of priority to a prior-filed nonprovisional application was submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3). However, the petition does not comply with item (1). In reviewing the chain of applications to which applicant is seeking a claim for priority, it

is noted that the present nonprovisional application claiming the benefit of the prior-filed provisional applications was not filed within twelve months of the filing date of the prior-filed provisional applications.

Application Nos. 60/179,046 and 60/179,041 were both filed January 31, 2000, and expired on the twelve-month anniversary of this date (January 31, 2001), pursuant to 35 U.S.C. §111(b)(5). The present application was not filed until January 2, 2002, which is subsequent to the expiration of the provisional application, to which priority is claimed.

35 U.S.C. §119 permits a non-provisional application to claim the benefit of the filing date of a previously filed, provisional application provided there is inventorship overlap between the continuing application and the parent application. Here, the applications for which the benefit is sought, 60/179,046 and 60/179,041, were filed more than one year before the present application was filed. As such, there is no copendency between the applications. As set forth in 35 U.S.C. §119(b)(e):

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed (emphasis added) and if it contains or is amended to contain a specific reference to the provisional application.

Before a petition can be granted in the present application, petitioner must file a renewed petition titled under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6), accompanied by a certificate of correction with the benefit of provisional application nos. 60/179,046 and 60/179,041 being claimed through non-provisional application no. 09/774,121.

Further correspondence with respect to this matter should be addressed as follows:


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Any questions concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.


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